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| 10/553,066                             | 08/09/2006  | Nicholas Leo Weatherby | 0126-028P/FLS       | 4274             |
| 22831                                  | 7590        | 10/14/2008             | EXAMINER            |                  |
| SCHWEITZER CORNMAN GROSS & BONDELL LLP |             |                        | BODAWALA, DIMPLE N  |                  |
| 292 MADISON AVENUE - 19th FLOOR        |             |                        |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/553,066             | WEATHERBY ET AL.    |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | DIMPLE N. BODAWALA     | 1791                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 July 2008.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 22-24,30-34 and 36-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 22-24,30-34 and 36-42 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Response to Amendment***

- ❖ Claims 22-24, 30-34 and 36-42 are pending.
- ❖ Claims 25-29 and 35 are cancelled.

In view of the amendment, filed on 7/16/2008, following rejection are maintained as a reason of record from the previous office action, mailed on 4/16/2008.

- ❖ Rejection of claims 22, 30, 31, 33, 34 and 39 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-9 of US 7,306,693 in view of Miyazaki et al. (JP 01016632).
- ❖ Rejection of claims 22-24, 30-34 and 36-42 under 35 USC 103(a) as being unpatentable over Boyce (US 6,228,312) in view of Miyazaki et al. (JP 01016632).

### **Declaration**

1. The declaration filed on 7/16/2008 has been considered but is ineffective to overcome the references Boyce (US 6,228,312) and Miyazaki et al. (JP 01016632) because of following reasons:

- Application Serial number is not correct on the declaration.

- Does not state what type of Declaration.
- No experimental data or evidence to show TWINTEX is porous.
- No experimental data or evidence to show liner of Miyazaki is not an air permeable liner.
- Does not include willful false statement are punishable by fine or imprisonment, or both (18 U.S.C. 1001).

2. The declaration, filed on 7/16/2008, is failed to disclose or suggest or show experimental data or other evidence to show TWINTX is porous.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 22-24, 30-34 and 36-42 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. Claim 22 is rejected because claim 22 cites limitation such as “apparatus including a tubular layer of air-permeable composite material”, which is not supported by specification of the instant application.

***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 22, 30, 31, 33, 34, and 39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-9 of U.S. Patent No. 7,306,693 in view of Miyazaki et al. (JP 01016632).

8. U S Patent No. 7,306,693 claims all claimed structural limitations as cited in the claims of the instant application. It further claims that the outer member of the central portion comprises a support means for providing an air gap, but fails to claim a further heating means as a support means.

9. In the analogous art, Miyazaki et al. discloses lining technique for pipeline (duct) which comprises a plastic pipe (1) is heated uniformly in the direction of the thickness thereof by the heating means (2, 5) from the inside and outside of the same, wherein the heating means (2) is disposed in the inner side of the pipe, and the further heating means (5) is surrounded to the heating means (8), wherein the further heating means would be capable to ensure more uniform heating of both the liner and composite material (See figure 1). It further teaches that the further heating means (5) being moveable with the first heating means (2) and comprising a tubular member spaced inward from the duct and surrounding the first heating means (2) (See figures 1-3).

10. However, claim 22 cites an intended use of the structural limitations such as “composite layer to deflect hot gas passing through the layer of composite material back toward the composite layer”. If prior arts disclose all claimed structural limitations as discussed above, so the structural limitations of the arts are capable to operate in desired functions as required.

Intended use has been continuously held not to be germane to determining the patentability of the apparatus, *In re Finsterwalder*, 168 USPQ 530. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235, 238. Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during the intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666. A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647.

11. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the invention of (U S Patent No. 7,306,693) by providing the further heating means as support means because such an alignment is involved to heat the pipe which comprises a liner with a layer of composite material uniformly in the direction of the thickness (See abstract) as suggested by Miyazaki. As we know that the claiming of new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable, *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

***Claim Rejections - 35 USC § 103***

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. **Claims 22-24, 30-34 and 36-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyce (U S Patent No. 6,228,312) in view of Miyazaki et al. (JP 01016632).**

14. As to claim 22, Boyce ('312) discloses a lining pipe as a lining duct having a flexible liner (5), wherein liner (5) including a layer of composite material comprising thermoplastic material and reinforcing fibers (See abstract) into a structural member within a duct (4), duct (4) comprises a front portion, a rear portion and a central portion, wherein a front portion adapted to be inserted in liner, a central portion having heating means (8) on one side of the layer of the composite material, and a rear portion having consolidation means (9) for forcing the layer of the composite material toward the duct (4) for consolidation and cooling under pressure for forming a structural member (See figure 3, col.4 lines 46 through col.5 lines 20).

15. As to claims 31-34, 36-38, it further teaches that the unheated compress air is used as the consolidation means forcing the heated layer of the composite material into contact with the duct (See col.7 45-58). It further teaches that the compressed air inflates a flexible bag means (10) which acts

on the layer of composite material, wherein the bag (10) attached to the central portion, and expanded from the rear, unrolling as it does so (See col.7 lines 59-62, col.8 lines 52-60). It further teaches that the bag (10) is made of plastic, which is silicon-based material (See col.5 line 32). It further teaches that the latter involves inserting a pipe liner is fabricated from PVC (See col.1 lines 30-32), which can be understandable that the bag is of PVC.

16. As to claim 39, it further teaches that the liner (5) includes an outer thermoplastic layer between the duct (4) and the composite layer (See col.2 lines 44-64).

17. As to claims 41 and 42, figure 3 further teaches that the compressed air and power for the heating means (8) are supplied through the lines attached to the apparatus (See figure 4). Figure 3 further discloses a mobile unit for generating compressed air supply and the power to operate the apparatus.

18. Boyce ('312) discloses all claimed structural limitations as discussed above but fails to teach or suggest a further heating means and a winch.

19. As to claims 22, 30, in the analogous art, Miyazaki et al. discloses lining techniques for pipeline which comprises a pipe with liner, wherein liner is made of layer of composite material having front (2b), central (2c+2d), and rear portion (2a) (See figure 3). It further comprises an apparatus having a heating pig (2) and tubular heater (5), wherein the tubular heater (5) as a

further heating means disposed in the outer member of the lining pipe, and the heating pig (2) as a heating means is disposed in the inner side member. It further teaches that the pipe (1) is heated by a inner heating means (2) and outer heating means (5), wherein the pipe (1) is heated uniformly in the direction of the thickness thereof by the heating from inside and outside under compression (See abstract). It would be understandable that the tubular heating means (5) as a further heating means is passive and active heating device containing heating elements. It further teaches that the hot gas is directed from the air gap (shown as arrows in figures) forwardly to provide pre-heating of the liner at the front portion (2b), wherein the hot gas is produced by heating a supply of compressed air (10) (See abstract). It further teaches that the further heating means (5) being moveable with the first heating means (2) and comprising a tubular member spaced inward from the duct and surrounding the first heating means (2) (See figures 1-3).

20. As to claim 23, it further teaches that the pipe (1) is heated by a inner heating means (2) and outer heating means (5), wherein the shape of the further heating means is a tubular and heated in a direction of thickness and it is well known in the art that the passive heating means relies on orientation and design of the heating means (see NPL, cited on PTOL-892 for further clarification of passive heating means), wherein tubular heating

means inherently suggests that the further heating means is a passive heating device.

21. As to claim 24, it further teaches that the pipe (1) is heated uniformly in the direction of the thickness thereof by the heating from inside and outside under compression (See abstract), wherein the compressed air and the power for the heating means are supplied through the line (6, 7,8a, 9, 10) attached to the apparatus, which is a function of mechanical means, and it is well known in the art that the active heating means is known as mechanical means for trapping or supplying heat, wherein the function of heating means inherently suggests that further heating means is active heating device containing heating elements for heating the pipe uniformly in the direction of the thickness under compression.

22. As to claim 41, it further teaches that the compressed air and the power for the heating means are supplied through the line (6, 7,8a, 9, 10) attached to the apparatus.

23. As to claims 40, figures 1 and 2 teach the apparatus which is moved along the duct (4) by being winched from its front portion (2b).

24. Furthermore, claims 36-38 recite claimed limitations of a content, such as Flexible bag, but fail to further limit of the subject matter such as a liner

conversion apparatus, wherein these claims treat as an intended use, which is given no patentability weight.

25. However, claim 22 cites an intended use of the structural limitations such as “composite layer to deflect hot gas passing through the layer of composite material back toward the composite layer”. Furthermore, claims of the instant application cited claimed structural limitations with the intended uses such as “consolidation means for forcing the layer of composite material after heating thereof towards the duct for consolidation and cooling under pressure to form the structural member”; “first heating means for producing hot gas under pressure”; and “further heating means is adapted to ensure more uniform heating of both the liner and composite material” as cited in claim 22; “means for directing hot gas from the air gap forwardly to provide pre-heating of a front portion of the liner” as cited in claim 30; “a source of compressed air is provided to deliver compressed air to the apparatus” as cited in claims 31-33; and “compressed air and power for the heating means and to operate apparatus” as cited in claims 41 and 42. As we know that the claim which is involved as an intended use, is given no patentability weight. Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault, 164 USPQ 666*. A

recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitation, *Ex parte Masham*, 2 USPQ2d 1647. Therefore, if prior arts disclose all claimed structural limitations as discussed above, wherein all structural limitations would be capable to do all functions as cited in the claims of the instant application.

26. Furthermore, claims of the instant application discloses process limitation for operating apparatus such as “hot gas is produced by heating compressed air from the source thereof” as cited in claim 31; and “the consolidation means is actuated by compressed air from the source to force the heated layer of the composite material into contact with the duct” as cited in claim 32. As we know that with regard to claim recitation regarding the method of forming apparatus, such relate only to the method of producing the claimed apparatus, which does not impart patentability to the apparatus claims. Note that determination of patentability is based on the product apparatus itself, *In re Brown*, 173 USPQ 685, 688, and the patentability of a product does not depend on its method of production, *In re Pilkington*, 162 USPQ 145, 147; See also *In re Thorpe*, 227 USPQ 964 (CAFC 1985). Note also that it is Applicant’s burden to prove that an unobvious difference exists,

*In re Marosi*, 218 USPQ 289, 292-293 (CAFC 1983), and Applicant must show that different methods of manufacture produce article having inherently different characteristics, *Ex parte Skinner*, 2 USPQ2d 1788.

27. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Boyce ('312) by providing a further heating means because such an alignment is involved to heat the pipe from the outside uniformly in the direction of the thickness (See abstract) as suggested by Miyazaki et al. (JP 01016632).

28. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the invention of Boyce ('312) by providing a winch in the front portion of the duct because such an alignment is involved to move the apparatus along the duct during the operation as suggested by Miyazaki et al. (JP 01016632).

**New Ground of Rejection**

***Claim Rejections - 35 USC § 103***

29. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

30. **Claims 22-24, 30-34 and 36-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weatherby et al. (WO 02/25156 having similar translation of US 7,306,693) in view of Miyazaki et al. (JP 01016632).**

31. As to claim 22, Weatherby et al. discloses lining duct which comprises moveable through duct and adapted to convert a flexible liner, including tubular layer of composite material having an inside and an outside and comprising thermoplastic material and reinforcing fibers into a structural member within the duct (see col.1 lines 57-60), wherein apparatus comprising a front portion adapted to be inserted into the liner, a central portion having a first heating means on the inside of the layer of the composite material, and a rear portion having consolidation means positioned to force the layer of composite material, after heating thereof, toward the duct for consolidation and cooling under pressure to form the structural member (See col.1 lines 57-66). It further teaches that the first heating means producing the hot gas under pressure, the central portion being so constructed and arranged to force the hot gas under pressure outwardly through the layer of composite material from the inside thereof to heat the layer of composite material and to provide an air gap on the outside of the layer of composite material while such heating take place (See col.1 line 66 through col.2 line 4). It further teaches that the composite material is one knitted, braided or woven (See col.4 lines 15-25), which inherently suggests that the flexible liner is a tubular layer of air-permeable composite material. It further suggests that

the heating means (8) heats the compressed air producing hot gas which is then applied to the inside of the composite layer (3) (See col.4 lines 33-39).

32. As to claim 30, it further teaches that the means for pre-heating front portion of the liner comprising means for directing hot gas from the air gap forwardly (See col.2 lines 18-19).

33. As to claim 31, it further teaches that the source of compressed air is provided, together with means to deliver compressed air from the source to the apparatus, and heating means (8) is operable to produce the hot gas by heating the compressed air from the source thereof (See col.3 lines 44-46; col.4 lines 39-43).

34. As to claim 32, it further teaches that the source of compressed air is provided, together with means to deliver compressed air from the source to the apparatus, and consolidation means is actuated by compressed air from the source and is operative to force the heated layer of composite material into contact with the duct (See col.3 lines 39-46; col.4 lines 39-43).

35. As to claim 33, the source of compressed air is provided, together with means to deliver compressed air from the source to the apparatus, the consolidation means is an inflatable flexible bag (11) positioned within the composite material (3) and compressed air from the source is directed to

inflate the bag (11) which acts on the layer of the composite material (See figures 2-3; col.4 lines 39-47).

36. As to claim 34, it further suggests that the flexible bag (11) is attached to the central portion (See figures 2-3).

37. As to claim 38, it further suggests that the bag is of silicone based material (See col.5 lines 20-25).

38. As to claim 39, it further teaches that the liner includes an outer thermoplastic layer between the duct and the layer of composite material (See col.2 lines 60-61).

39. As to claim 40, it further teaches that the apparatus further comprises winch cable attached to the front portion whereby the apparatus is moved along the duct by being winched from the front portion (see col.2 lines 63-64).

40. As to claim 41, it further teaches that compressed air and power lines are attached to the apparatus for applying the heating and consolidation means (See col.2 lines 63-65).

41. As to claim 42, it further discloses a mobile unit generates the compressed air and the power to operate the apparatus (see col.2 lines 65-67).

42. Weatherby et al. discloses all claimed structural limitations as discussed above but fails to teach or suggest a further heating means.

43. As to claims 22, 30, in the analogous art, Miyazaki et al. discloses lining techniques for pipeline which comprises a pipe with liner, wherein liner is made of layer of composite material having front (2b), central (2c+2d), and rear portion (2a) (See figure 3). It further comprises an apparatus having a heating pig (2) and tubular heater (5), wherein the tubular heater (5) as a further heating means disposed in the outer member of the lining pipe, and the heating pig (2) as a heating means is disposed in the inner side member. It further teaches that the pipe (1) is heated by a inner heating means (2) and outer heating means (5), wherein the pipe (1) is heated uniformly in the direction of the thickness thereof by the heating from inside and outside under compression (See abstract). It would be understandable that the tubular heating means (5) as a further heating means is passive and active heating device containing heating elements. It further teaches that the hot gas is directed from the air gap (shown as arrows in figures) forwardly to provide pre-heating of the liner at the front portion (2b), wherein the hot gas is produced by heating a supply of compressed air (10) (See abstract). It further teaches that the further heating means (5) being moveable with the first heating means (2) and comprising a tubular member spaced inward from the duct and surrounding the first heating means (2) (See figures 1-3).

44. As to claim 23, it further teaches that the pipe (1) is heated by a inner heating means (2) and outer heating means (5), wherein the shape of the further heating means is a tubular and heated in a direction of thickness and it is well known in the art that the passive heating means relies on orientation and design of the heating means (see NPL, cited on PTOL-892 for further clarification of passive heating means), wherein tubular heating means inherently suggests that the further heating means is a passive heating device.

45. As to claim 24, it further teaches that the pipe (1) is heated uniformly in the direction of the thickness thereof by the heating from inside and outside under compression (See abstract), wherein the compressed air and the power for the heating means are supplied through the line (6, 7,8a, 9, 10) attached to the apparatus, which is a function of mechanical means, and it is well known in the art that the active heating means is known as mechanical means for trapping or supplying heat, wherein the function of heating means inherently suggests that further heating means is active heating device containing heating elements for heating the pipe uniformly in the direction of the thickness under compression.

46. Furthermore, claims 36-38 recite claimed limitations of a content, such as Flexible bag, but fail to further limit of the subject matter such as a liner

conversion apparatus, wherein these claims treat as an intended use, which is given no patentability weight.

47. However, claim 22 cites an intended use of the structural limitations such as “composite layer to deflect hot gas passing through the layer of composite material back toward the composite layer”. Furthermore, claims of the instant application cited claimed structural limitations with the intended uses such as “consolidation means for forcing the layer of composite material after heating thereof towards the duct for consolidation and cooling under pressure to form the structural member”; “first heating means for producing hot gas under pressure”; and “further heating means is adapted to ensure more uniform heating of both the liner and composite material” as cited in claim 22; “means for directing hot gas from the air gap forwardly to provide pre-heating of a front portion of the liner” as cited in claim 30; “a source of compressed air is provided to deliver compressed air to the apparatus” as cited in claims 31-33; and “compressed air and power for the heating means and to operate apparatus” as cited in claims 41 and 42. As we know that the claim which is involved as an intended use, is given no patentability weight. Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault, 164 USPQ 666*. A

recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitation, *Ex parte Masham*, 2 USPQ2d 1647. Therefore, if prior arts disclose all claimed structural limitations as discussed above, wherein all structural limitations would be capable to do all functions as cited in the claims of the instant application.

48. Furthermore, claims of the instant application discloses process limitation for operating apparatus such as “hot gas is produced by heating compressed air from the source thereof” as cited in claim 31; and “the consolidation means is actuated by compressed air from the source to force the heated layer of the composite material into contact with the duct” as cited in claim 32. As we know that with regard to claim recitation regarding the method of forming apparatus, such relate only to the method of producing the claimed apparatus, which does not impart patentability to the apparatus claims. Note that determination of patentability is based on the product apparatus itself, *In re Brown*, 173 USPQ 685, 688, and the patentability of a product does not depend on its method of production, *In re Pilkington*, 162 USPQ 145, 147; See also *In re Thorpe*, 227 USPQ 964 (CAFC 1985). Note also that it is Applicant’s burden to prove that an unobvious difference exists,

*In re Marosi*, 218 USPQ 289, 292-293 (CAFC 1983), and Applicant must show that different methods of manufacture produce article having inherently different characteristics, *Ex parte Skinner*, 2 USPQ2d 1788.

49. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the invention of Weatherby et al. by providing a further heating means because such an alignment is involved to heat the pipe from the outside uniformly in the direction of the thickness (See abstract) as suggested by Miyazaki et al. (JP 01016632).

### ***Response to Arguments***

50. Applicant argues that the prior art, Boyce and Miyazaki fail to disclose "further heating means" to be tubular member, moveable with the first heating means and both spaced from the duct being lined and surrounding the first heating means and the composite layer. The specified function of the tubular member is to deflect hot gas passing through the composite material back toward the composite material to insure more uniform heating. No similar structure is shown in either Boyce or Miyazaki.

51. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

52. In response to applicant's argument that the specified function of the tubular member is to deflect hot gas passing through the composite material back toward the composite material to insure more uniform heating, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, and then it meets the claim.

53. In response to applicant's arguments, the recitation of the specified function of the tubular member is to deflect hot gas passing through the composite material back toward the composite material to insure more uniform heating has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

***Conclusion***

54. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIMPLE N. BODAWALA whose telephone number is (571)272-6455. The examiner can normally be reached on Monday - Friday at 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PHILLIP C. TUCKER can be reached on (571) 272-

1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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